IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Louis R. Degenaro, et al.

Serial No.:   10/665,564   Group Art Unit: 2165

Filed: September 22, 2003   Examiner: Syed, Farhan M.

For: VIRTUAL RESOURCES METHOD, SYSTEM, AND SERVICE

Honorable Commissioner of Patents
Alexandria, VA 22313-1450
MAIL STOP Appeal Brief-Patents

APPELLANTS' REPLY BRIEF ON APPEAL

Sir:

         Appellants respectfully respond herein to the Examiner's Answer mailed on

April 22, 2011, for the above-referenced Application.

         (1)The disclosure in the publication document of Severin '261 is not fully

supported by the provisional application, Severin '251.

         The Examiner alleged that the non-provisional application, Severin '261 is

supported in its entirety by the provisional application Severin '251. The Examiner

reasoned that "[a]ccording to MPEP 307, [i]f an application which claims the earlier

filing date of a provisional application includes only subject matter which formed a

part of the provisional application, an assignment recorded against the provisional

with be effective in the later application."

However, respectfully, the Examiner merely asserting a conclusion without

being able to address the issues raised by Appellants in the Appeal Brief.

The Examiner cites MPEP 307 and mentions specifically about an

assignment recorded against the provisional application. Respectfully, MPEP 307

relates to ownership and assignment to issue of patent to an assignee and does not

appear to even include the text cited by the Examiner.

Respectfully, the Examiner should look instead to where a provisional patent

application under the statutory requirements of 35 U.S.C. § 111(b) must satisfy the

written description, enablement and best mode requirements of 35 U.S.C. § 112 in

order for a later filed, non-provisional patent application to claim the benefit of the

provisional application's filing date. As seen in the examples provided in the

Appeal Brief, the written description, enablement and best mode requirements of 35

U.S.C. § 112 are not fully provided by the provisional application in order for the

later filed non-provisional patent application to claim the benefit of the provisional

application's filing date. See also, MPEP §601.

(2) Severin '261 cannot be used as a reference since it has a later U.S. filing

date than the present Application.

The Examiner responds by stating that according to MPEP 901.03, a U.S.

patent application publications are prior art under 35 U.S.C. 102(e) as of the earliest

effective U.S. filing date of the published application. Ergo, the earliest effective

filing date of Severin '261 is that of the provisional application filed July 2, 2003.

However, respectfully, this point is related to the previous point in that if the

provisional application, Severin '251, does not satisfy all of the requirements of 35

U.S.C. §112, the non-provisional application, Severin '261 is then not entitled to the

earlier filing date. Therefore, the non-provisional application of Severin '261

cannot be used as a reference in the anticipation rejection under 35 U.S.C. 102(e).

In addition, the recitation of the particular parts relied on (as required under

MPEP §1.104) from the provisional application by the Examiner after prosecution

is closed, does not properly afford the Appellants proper due process as would be

provided if the prosecution is open.

(3) The cited art does not teach or suggest constructing at least one virtual

resource independent of an actual resource.

The Examiner responds by alleging that the cited art teaches constructing (i.e.

constructs. Furthermore, the Examiner finds support for construction in the

provisional application, see page 6, which defines a constructor as a set of

programming logic associated with the creation of an instance. The Examiner states

that this concept is consistent with Appellant's disclosure, see page 14, lines 17-20,

which describe constructing as to allow authoring of logic by a non-programmer or

the like.)(paragraph [0248]) at least one virtual resource independent (a virtual

model implementation. In addition, the Examiner finds support for a virtual model

implementation as a model controller on page 24 of the provisional application. The

Examiner notes that in Appellant's disclosure, see page 14, lines 22-25, resources

are a loose term which in this context means data (e.g, databases, objects, attributes,

etc.) or function (e.g. SOL queries, object method calls, etc .. Based on this

rationale, the Examiner alleges that Severin discloses virtual implementation refers

to assemblies of meta-implementation (including other virtual implementation for a

specific descriptor), where virtual implementation may use a plain object oriented

implementation.)(Paragraphs [0078, 0196, 0248]) of an actual resource (i.e. Severin

discloses that during real implementation, or at run-time virtual resources are

assigned to each descriptor . The Examiner finds support for actual resource in the

view controller of the provisional application, see page 25.)(paragraph [0198, 0248,

0550]).

However, Severin '261 recites that "[a]ccessors may use the assemblies of

virtual implementations in exactly the same way as a real implementation... [t]he

difference is that virtual implementations are constructed (and optionally

modifiable) at runtime. No source code is written, no source code is compiled, and

no source code needs to be managed." See ¶ 20 of Severin '261. Therefore,

Severin '261 is not relating the virtual implementation with the virtual resources as

claimed. The virtual implementation is constructed at run-time and no source code

is authored.

The claimed invention, however recites that the virtual resource comprises a

resource utilized at a logic authoring time, while the actual resource comprises a

resource utilized at a runtime. Severin '261, however, has the virtual

implementation constructed at run-time.

Therefore, the examples used by the Examiner of the virtual implementation

and the separation (*e.g.*, "[t]he component integration engine server separates

services for logical and security reasons. The primary separation is the virtual host"

) is not relevant. See ¶ 550 of Severin '261.

(4) The cited art does not teach or suggest connecting the actual resource to

the at least one virtual resource.

The Examiner responds by stating that the cited art teaches connecting (i.e.

Severin discloses creating connection between objects (e.g. virtual and actual)

dynamically at run-time.)(paragraph [0523]) the actual resource to the at least one

virtual resource (i.e. virtual resources are stored in a database. The Examiner finds

support in the Provisional Application, see page 23, second paragraph, 'interaction

between components ... ")(paragraphs [0248, 0437]).

However, Severin '261 recites that "[a] component integration engine of the

present invention may be used to create <u>connections between objects</u> dynamically at

run-time instead of creating object connections at compile-time... [t]his statement is

equivalent to saying that code is more reliable." See ¶ 523 of Severin '261,

emphasis added by Appellants.   Severin '261 is discussing the connections between

objects at run-time and not a connection by the actual resource to the virtual

resource as claimed.

(5) The cited art does not teach or suggest extracting at least one descriptor from said at least one retrieved virtual resource, wherein said virtual resource comprises a resource utilized at a logic authoring time, while said actual resource comprises a resource utilized at a run time.

The Examiner responds by stating that the cited art teaches extracting at least

one descriptor from said at least one retrieved virtual resource (i.e. descriptor

contains the descriptions of features and functionality allowed and required in an

implementation. The Examiner further alleges that it is a specific type of

metadata)(paragraph [0049]), wherein said virtual resource comprises a resource

utilized at a logic authoring time (i.e. virtual implementation using logic-based

program.)(paragraphs [0079, 0250]), while said actual resource comprises a

resource utilized at a runtime (i.e. Severin discloses that at run time model

substitution, object substitution, functional substitution, and data substitution occurs

at run-time. The Examiner also finds support for runtime in the Provisional

Application, see at least pages 20-21.)(paragraphs [0089-0092, 0411-0412, 0523]).

As mentioned above, since the virtual implementation is constructed at run

time, it is not related to the virtual resources. The "virtual implementation" refers

to assemblies of meta-implementations. See ¶79 of Severin '261. However, the

virtual implementations are constructed at runtime. See ¶248 of Severin '261.

Therefore, since the disclosures in Severin '261 does not teach the virtual

resource and the actual resource as claimed, Severin '261 also fails to teach of

extracting at least one descriptor from said at least one retrieved virtual resource.

Moreover, the correspondence to the provisional application '251 provided

now by the Examiner is not relevant since the disclosure relied on by the Examiner

does not teach the claimed invention.

As mentioned in MPEP 2131 for anticipation rejections, "[t]he identical

invention must be shown in as complete detail as is contained in the ... claim."

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.

Cir. 1989)." Therefore, since as shown above and in the Appeal Brief, the identical

invention is not shown in the complete details of the claims. Therefore, claims 1-37

are not anticipated by Severin.

CONCLUSION

In view of the foregoing, Appellants submit that claims 1-37, all of the claims presently pending in the application, are patentably distinct over the alleged prior art of record and are in condition for allowance. Thus, the Board is respectfully requested to remove the rejections of claims 1-37.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: June 22, 2011

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Sam S. Sahota, Esq.
Registration No. 47,051

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
   LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 48150